

REMARKS

In the Office Action¹, the Examiner rejected claim 22 under 35 U.S.C. § 101; and rejected claims 1-15, 20, 22, and 23 under 35 U.S.C. § 103 as unpatentable over U.S. Patent App. Pub. No. 2002/0018228 to Torigoe ("*Torigoe*") in view of U.S. Patent No. 6,827,279 to Teraura ("*Teraura*").

Applicants have amended claims 2 and 22 and canceled claim 23 without prejudice or disclaimer. Claims 1-22 remain pending, and claims 16-19 and 21 have been withdrawn.

Regarding the rejection of claim 22 under 35 U.S.C. § 101, Applicants have amended claim 22 to recite a "computer-readable recording medium storing a computer-executable program which, when executed by a processor, performs a method," thereby positively reciting a structure. Therefore, claim 22 falls within the categories of patentable subject matter, and Applicants respectfully request reconsideration and withdrawal of the rejection of claim 22 under 35 U.S.C. § 101.

Applicants respectfully traverse the rejection under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original). In this application, a *prima facie* case of obviousness has not been established because the Examiner has not clearly articulated a reason why one of ordinary skill would find the claimed combination obvious in view of the cited references.

Claim 1 recites a image forming device including, for example:

...
a printing unit for printing the specified mark on a recording element including an IC tag when it is judged by said judgment unit that the instruction for adding the specified mark is included in the printing job; and
a writing unit for writing mark information indicating the specified mark's content on the IC tag included in the recording element when it is judged by said judgment unit that the instruction for adding the specified mark is included in the printing job.

(emphasis added). *Torigoe* does not disclose each and every element of Applicants' claimed invention.

Torigoe discloses an image processing apparatus including a judging means and a control means (paragraph 0023). The Examiner correctly states that *Torigoe* does not teach or suggest the claimed “printing unit” and “writing unit” (Office Action at page 7).

Teraura does not cure the deficiencies of *Torigoe*. *Teraura* discloses a “sheet of printing paper” comprising an RFID tag “supported by said sheet of paper for receiving, storing, and transmitting data through radio wave signals and storing said data” (col. 1, lines 35-38). According to *Teraura*, “RFID data” may include “permission data including identification data in said first data from said RFID tag of the sheet of document paper” and “inhibition data” (col. 3, lines 33-46).

As depicted in Fig. 6 of *Teraura*, “control circuit 29 judges whether the received data includes RFID data to be written in the RFID tag 14 in step A2. If the received data does not include the RFID data to be written in the RFID tag 14 (NO in step A2), the control circuit 29 controls the automatic paper feeding unit 8 in the printing unit 11 to select one of the paper trays 7 which contains sheets of printing paper without the RFID tags” (col. 7, lines 8-15). As stated in *Teraura*, “it is favorable that a software is delivered together with its manual. In this case, it is convenient that the software is stored in the RFID tag 14 as digital data and the manual is printed on the sheets of the printing paper 13. . . The data of the software is stored in the RFID tag 14, and the characters and graphic data included in the manual are transmitted to the copy machine 1. Here, if it is desired to restrict the persons having the authorization of copying the software or the manual, data specifying the persons who can copy the software or the manual can be stored as permission data, or inhibition data in the RFID tag 14” (col. 7, lines 24-36).

According to *Teraura*, permission or inhibition data may be stored in RFID tag 14. While *Teraura* may disclose printing information and an RFID tag 14, Applicants continue to assert that *Teraura* does not teach or suggest “a printing unit for printing the

specified mark on a recording element including an IC tag when it is judged by said judgment unit that the instruction for adding the specified mark is included in the printing job” in combination with “a writing unit for writing mark information indicating the specified mark's content on the IC tag included in the recording element when it is judged by said judgment unit that the instruction for adding the specified mark is included in the printing job,” as recited in claim 1.

Accordingly, the combination of *Torigoe* and *Teraura* does not teach or suggest claim 1. Furthermore, as outlined above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Therefore, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art and a *prima facie* case of obviousness has not been established.

Claim 1 is thus allowable, and claims 2-15 are also allowable at least due to their depending from claim 1. Independent claims 20 and 22, while of different scope, recites elements similar to those of claim 1 and are thus allowable over *Torigoe* and *Teraura* for at least the same reasons discussed above in regard to claim 1.

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 20, 2009

By: /David W. Hill/
David W. Hill
Reg. No. 28,220